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In re Application of :
Satoshiu Mikami et al :
Serial No.: 09/341,328 : PETITION DECISION
Filed: July 6, 1999 :
Attorney Docket No.: Kinoshita Case 209 :

This is in response to the petition under 37 CFR 1.181, filed November 4, 2004, requesting entry of a supplemental Appeal Brief.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on February 24, 2003, setting a three month shortened statutory period for reply, which set forth two different rejections under 35 U.S.C. 103(a) and an objection to new matter added by amendment. Applicants timely filed a Notice of Appeal followed by an Appeal Brief on October 9, 2003. The Appeal Brief under the heading "Issues" sets forth only one prior art rejection as being appealed. In view of the Final Office action, this was incorrect. The examiner, instead of notifying applicants of the deficiency of the Appeal Brief, prepared and mailed an Examiner's Answer on January 27, 2004, in which it was stated that since applicants had not argued the second rejection under 35 U.S.C. 103(a) it appeared that they acquiesced in the rejection.

Upon realization of the error of omission in the original Appeal Brief, applicants prepared and filed a Supplemental Brief on Appeal which included two introductory paragraphs explaining why the supplemental Brief was necessary and the entire previous Brief with additional arguments as to the second rejection under 35 U.S.C. 103(a). On July 6, 2004, the examiner refused entry of the Supplemental Brief on the grounds that it was directed to an issue not raised in the original Brief. Applicants failed to receive this communication until inquiry was made in September, 2004. A second request for entry of the Supplemental Brief was made on September 10, 2004. This request for entry was also refused by communication mailed October 18, 2004. This petition was filed November 4, 2004, requesting the Group Director direct entry of the Supplemental Brief.

DISCUSSION

Applicants argue that the examiner failed to follow Office procedure when finding the original Appeal Brief failed to address an outstanding ground of rejection and advise applicants that the

Appeal Brief, as filed, was defective. (See M.P.E.P. 1206.) A Brief is defective when it fails to address any proposed ground of rejection maintained by the examiner in a Final Office action. Here, the failure to address a ground of rejection appears to have been inadvertent. The Final Office action is drafted such that a first ground of rejection is set forth as in the previous Office action and then applicants' arguments with respect thereto are addressed. Then a second ground of rejection is set forth in such a manner that it could be misinterpreted as a continuation of the examiner's reply to applicants' arguments with respect to the first ground of rejection. The examiner, upon consideration of the Appeal Brief, should have held it defective in failing to address a ground of rejection and required submission of a new Brief. Alternatively the examiner could have accepted the Supplemental Appeal Brief as a new corrected Brief and prepared a new Examiner's Answer.

The petition is **GRANTED**.

The Supplemental Appeal Brief filed February 23, 2004, is hereby entered as applicants' Appeal Brief. The examiner is directed to prepare an appropriate Examiner's Answer in reply to the Brief, or take other appropriate action.

No fee for this petition is required and the petition fee paid of \$130.00 will be credited to applicants' Deposit Account No. 06-1382, as directed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



Bruce M. Kisliuk
Director, Technology Center 1600